

Application No.: 09/807,050

Docket No. D02197

A. Status of the Application

Claims 1-3, 5-7, 9, 10, 12 and 14-24 were pending in this application. With this response, the Applicant has requested the amendment of Claims 1, 6, 21 and 23, and the cancellation of Claims 2, 3, 711, 13, 15-2022 and 24. This leaves Claims 1, 5, 6, 9, 10, 12, 1421 and 23 still under consideration.

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B. Rejections of the Claims under 35 U.S.C. § 103

The Examiner rejected claims 1-3, 5, 21 and 22 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 6,055,560 ("Mills") in view of U.S. Patent No. 6,393,496 ("Schwaderer"). Of these claims, only Claims 1, 5 and 21 are still under consideration.

With respect to Claim 1, the Examiner contends that Mills discloses all of the claim elements, with the exception of "the means for executing said computer program code being located in said set-top terminal". For that particular limitation, the Examiner relies upon the Schwaderer reference. The Examiner characterizes Schwaderer as being in a "analogous art" and disclosing "an intelligent communication device (Abstract) and independent program (32), which runs on the set top box and accesses one or more servers to send and receive information (6: 24-30)."

Applicant has amended Claim 1 to include the limitation of Claim 2 – Namely, the user notification that applications recovered at the terminal have been registered and installed. The Examiner stated that such a feature/limitation was disclosed in Mills at column 19, lines 23-25. As the Mills patent has only 18 columns, Applicant assumes that the Examiner intended to communicate column 9, lines 23-25, and responds accordingly. Mills at column 9, lines 23-25 states:

The player shell retrieves from local storage (not shown) and provides the TV 106 (see FIG. 1) with a bitmap which usually displays "Welcome To Video On Demand" or the like. The software interfaces and player shell are stored in local memory such as a ROM 307.

Mills does not provide for the notification that a particular program has been recovered at the terminal and is now registered and installed. Mills clearly shows that the player shell functions to boot the set top box and display an initial, pre-programmed message to a user – A simple "Welcome" (Mills, column 9, lines 18-26). Mills fails to disclose or suggest the aspects of the Applicant's invention that were set forth in presently canceled Claim 2 (and now incorporated in presently amended Claim 1).

Without addressing if the combination of Mills and Schwaderer is indeed proper, Applicant submits that the independent program (32) which the Examiner views as being analogous to the Applicant's Application Programming Interface ("API"), is described by Schwaderer as "a software program which is designed to run on the set top box (323) and access one or more servers (15-18) via the network (12)" (Schwaderer column 6, lines 23-25). Independent program 32 is not an API.

Regardless of what one might consider the functionality of Schwaderer's "independent program 32", Applicant maintains that in view of Mills failing to disclose a system or method wherein a

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user is notified that a program has been recovered at a set top terminal, and then registered and installed, any combination of Mills and Schwaderer will fail to yield an invention that renders presently amended Claim 1 (or Claim 5 which depends thereon) unpatentable.

Similarly, Applicant submits that presently amended independent Claim 21, which includes the limitation of user notification that a program has been recovered at a set top terminal, and then registered and installed, is likewise patentable over a Mills/Schwaderer combination

The Examiner also rejected claims 6, 7, 9, 10, 12-14, 23 and 24 under 35 U.S.C. § 103 (a) as being unpatentable over Mills in view of Schwaderer and further in view of ITU-T/ISO publication ("ISO"). Of these claims, only Claims 6, 9, 10, 12, and 23 are still under consideration.

Applicant submits that presently amended independent Claims 6 and 23 are allowable over the Mills/Schwaderer/ISO combination suggested by the Examiner for the same reason that presently amended Claim 1 should be viewed as allowable over a Mills/Schwaderer combination. They all contain the limitation of user notification that a program has been recovered at a set top terminal, and then registered and installed. None of the cited references disclose or suggest such. As dependent Claims 9, 10 and 12 are all subject to this same limitation, they too are believed to be patentably distinguishable from a combination of the cited art. Reconsideration is requested.

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CONCLUSION

Having fully responded to the Office Action, the application is believed to be in condition for allowance. Should any issues arise that prevent allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

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Respectfully submitted,

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